Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

A-8919 (191930-1960)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/602,987	June 25, 2003

First Named Inventor

Wasilewski, et al.

Art Unit	Examiner
2131	Chai, Longbit

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

58169

Registration number if acting under 37 CFR 1.34 _____

/BAB/

Signature

Benjamin A. Balser

Typed or printed name

(770) 933-9500

Telephone number

October 26, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

      Wasilewski, et al.

Serial No.: 10/602,987

Filed: June 25, 2003

Confirmation No.: 6302

Group Art Unit: 2131

Examiner: Chai, Longbit

Docket No.: A-8919 (191930-1960)

For: **Method for Partially Encrypting Program Data**

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

      Applicant submits the following remarks in support of a Request for a Pre-Appeal Brief

Conference.

REMARKS

Applicant submits that the following clear legal deficiency exists in the rejection.

Namely, the previous final Office Action equates "selectively encrypting packets and using a

PID to select packets for transmission" with "selecting for encryption a digital bit stream from a

plurality of digital bit streams using an identifier," which are two functions that are known to be

technically very different from each other. Additionally, the previous Office Action rejects the

claims under 35 U.S.C. 112. Applicant has supplied an affidavit from an expert in support of its

position that the claims are enabled.

I.   Rejections of Independent Claim 1 Under 35 U.S.C. §103(a)

The Office Action rejects claim 1 under 35 U.S.C. §103(a) as allegedly being

unpatentable over *Wasilewski, et al.* (U.S. Patent no. 5,418,782). Applicant respectfully submits

that independent claim 1 is allowable for at least the reason that the '782 patent does not

disclose, teach, or suggest at least **using a packet identifier to select for encryption a portion**

of each of a plurality of digital bit streams from a transport streams. Even if, assuming for

the sake of argument, the '782 patent discloses that each type of stream is uniquely assigned a

packet ID, the '782 patent fails to disclose using a packet identifier to select for encryption a

portion of each of a plurality of digital bit streams from a transport streams. The '782 patent

fails to disclose how the packets are selected *for encryption*. The Office Action alleges that the

'782 patent makes it obvious to use the PID to select which packets are encrypted. In the '782

patent, the system could use some other method for selecting which packets to encrypt. For

instance, any packet following an audio packet could be selected for encryption. Alternatively,

every fourth packet could be selected for encryption. To allege that using a PID is obvious uses

impermissible hindsight. "Defining the problem in terms of its solution reveals improper

hindsight in the selection of the prior art relevant to obviousness." *Amazon.com Inc. v.*

Barnesandnoble.com Inc., 53 U.S.P.Q.2d 1115, 1126 (Wash. 1999). Additionally, the Office

Action must offer a reason that it would have been obvious to combine elements that are

disclosed in the reference, but used for a different purpose. The Office Action fails to meet this

requirement. Applicant does not dispute that a PID is disclosed in the reference. However, the

PID is exclusively disclosed in the reference as a means to select packets for transmission. The

'782 patent discloses **nothing** about how to select which packets are encrypted. Any allegation

that using one particular means over many others must be considered hindsight reconstruction

and is impermissible under the law. Therefore, the '782 patent does not disclose nor make

obvious each element of independent claim 1, and the rejection should be withdrawn for at least

that reason.

II.   Rejections of Independent Claim 13 Under 35 U.S.C. §103(a)

The Office Action rejects claim 13 under 35 U.S.C. §103(a) as allegedly being

unpatentable over *Wasilewski, et al.* (U.S. Patent no. 5,418,782). Applicant respectfully submits

that independent claim 13 is allowable for at least the reason that the '782 patent does not

disclose, teach, or suggest at least **using an identifier to select for encryption a portion of**

elementary bit streams from a plurality of programs. Even if, assuming for the sake of

argument, the '782 patent discloses that each type of stream is uniquely assigned a packet ID, the

'782 patent fails to disclose using an identifier to select for encryption a portion of elementary bit

streams from a plurality of programs. The '782 patent fails to disclose how the packets are

selected *for encryption*. The Office Action alleges that the '782 patent makes it obvious to use

the PID to select which packets are encrypted. In the '782 patent, the system could use some other method for selecting which packets to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. To allege that using a PID is obvious uses impermissible hindsight. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Amazon.com Inc. v. Barnesandnoble.com Inc.,* 53 U.S.P.Q.2d 1115, 1126 (Wash. 1999). Additionally, the Office Action must offer a reason that it would have been obvious to combine elements that are disclosed in the reference, but used for a different purpose. The Office Action fails to meet this requirement. Applicant does not dispute that a PID is disclosed in the reference. However, the PID is exclusively disclosed in the reference as a means to select packets for transmission. The '782 patent discloses **nothing** about how to select which packets are encrypted. Any allegation that using one particular means over many others must be considered hindsight reconstruction and is impermissible under the law. Therefore, the '782 patent does not disclose nor make obvious each element of independent claim 13, and the rejection should be withdrawn for at least that reason.

CONCLUSION

For at least the reasons set forth above, favorable reconsideration and allowance, or the

re-opening of prosecution on the merits of the present application and all pending claims are

hereby courteously requested.

Respectfully submitted,

THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.

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